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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,502	08/22/2001	Philipp G. Kornreich	270_094CIPofNP	8052
20874	7590	07/13/2004	EXAMINER	
WALL MARJAMA & BILINSKI 101 SOUTH SALINA STREET SUITE 400 SYRACUSE, NY 13202			HOFFMANN, JOHN M	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,502

Applicant(s)

KORNREICH ET AL.

Examiner

John Hoffmann

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1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1- 2132 are rejected under 35 U.S.C. 102(b) as being anticipated by Howard 4428761.

The invention is disclosed at col. 1, lines 6-50; col, 7, lines 21-26, 40-45 and col. 6, line 42. Howard does not disclose the temperature and flow ranges. However, the Howard substrate tube is quartz. Applicant's invention also uses quartz (i.e. pure fused silica (see col. 11, lines 1-9).

It is inherent that the cladding 10 and the core 22 and/or 24 would have overlapping flow ranges, because both must be drawn to form the fiber simultaneously. Therefore they would have the same temperature (T) when they are drawn. Therefore the flow range of each will overlap at least at the actual draw temperature. It is inherent that the glasses would also flow at a temperature of T+1 and T+2 because the glasses would still be liquid. Thus the range T+1 to T+2 is an overlapping flow range. The Howard metal clearly flows at T: T is a flow point which is below the T+1 to T+2 range.

Furthermore, page 4, lines 29-30 of Applicant's specification state that the material "must have a flow point which lies below the flow range for the glass. " A

complete reading of that paragraph indicates that such is necessary for having a continuous and coherent material. It is clear that Howard's metal is continuous, thus the method must have had a flow point that is below the flow range for the glass. Also, lines 5-15 of that page identify how the process fails if the proper plaso-viscosity properties are not met. Since the Howard process works and does the same thing that Applicant does, the Howard inherently has to meet the current flow limitations. The teachings of the present specification appear to spell out what is required to make the fiber - there is no indication that the present invention results in an improved method.

Claims 2-4 are clearly met.

Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Krol 5838868.

Figures 6-7, Col. 3, lines 15-63 disclose the invention except for the temperature limitations. Krol does everything that Applicant does and gets the same results, therefore the temperature limitations are inherently met. As discussed above (and by Applicant) the plas -viscosity limitations "must" be met to make and use the invention. Therefore Krol must have met the limitations to make the Krol fiber.

Allowable Subject Matter

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

The argument pertaining to the 112 rejection was persuasive.

Applicant's arguments filed 22 June 2004 regarding the prior art have been fully considered but they are not persuasive.

It is argued that Howard has a circumferentially patterned cladding layer, and does not have a continuous film throughout the entire length of the fiber. It appears that Applicant is interpreting the claims more narrowly than Examiner. The layers need only be continuous in the axial direction – they need not be continuous in the radial direction.

A fair reading of the relevant portions indicated in the rejection (specifically col. 7, lines 40-45) is that Howard contemplates fibers with patterns around the circumference, it is only a further embodiment that has an axial pattern. If there is no pattern in the axial direction, then it has to be continuous in the axial direction.

Furthermore the drawings reasonably suggest that Howard is mostly interested in circumferential patterns. If axial patterning was to be a significant feature of the invention, one would expect that there would be disclosure of a specific axial pattern to pattern the circumferential patterning.

It is argued that Krol does not teach the overlapping flow ranges. The rejection clearly points out how/why this limitation is met.

It is further argued that Krol has semiconductors which are unsuitable and would not operate in the range of 600-1500. First the claims do not require that the semiconductor be ever heated to a temperature within that range. Second, it is deemed that other of the Krol Semiconductors do operate at that temperature: Krol teaches using CdTe – just like applicant uses.

It is further argued that the claims now indicate that the fiber is “suitable” to affect amplification. This is not persuasive. (1) the claims do not mention the fiber is “suitable” for anything. (2) Col. 2, line 22 of Krol is clear that an amplifier results. (3) The phrase “to affect amplification” reasonably signifies an intention. Whereas, such a phrase can also reasonably convey a result, the Office interprets claims with their broadest reasonable interpretation. Presently, the expression of an intended result creates a broader claim than would the expression of an actual result. Therefore the Office interprets the claim using the broadest meaning, namely the claim requires the intention of a result. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). When one uses the Krol invention, it is irrelevant as to whether it is “to affect amplification”. And if the intention “to affect amplification” it would seem that one could avoid infringement simply by making the

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intention "to sell the fiber to someone else" who may or may not decide to use it to affect amplification. The claim does not recite any step of amplifying light – so none is necessary.

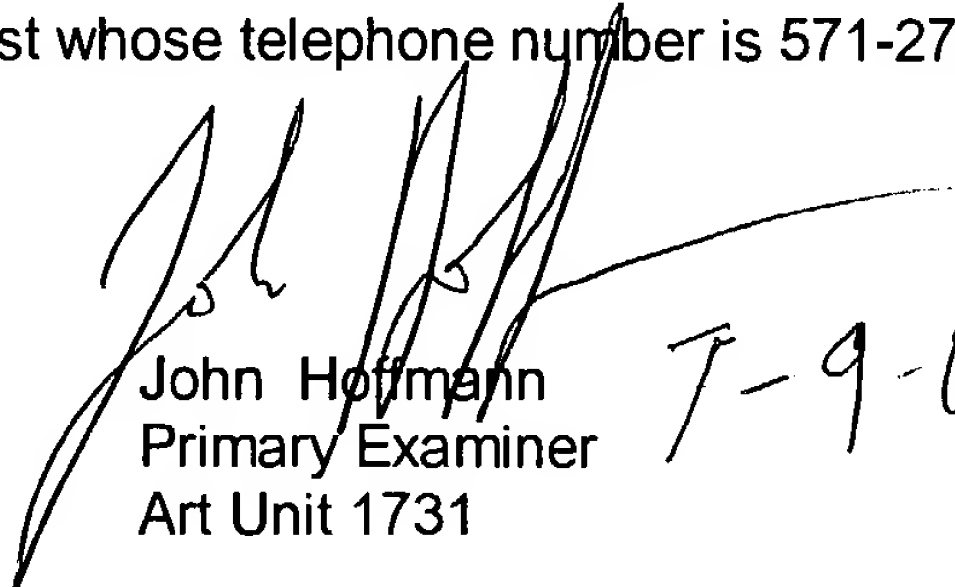
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fujitsu is cited as being relevant to the present disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1700.


John Hoffmann
Primary Examiner
Art Unit 1731

T-9-04

jmh